

1501A–570; amended Pub. L. 107–273, div. C, title III, §13202(c)(1), Nov. 2, 2002, 116 Stat. 1902; Pub. L. 112–29, §6(a), Sept. 16, 2011, 125 Stat. 303.)

AMENDMENT OF SECTION

Pub. L. 112–29, §6(a), (c)(2), Sept. 16, 2011, 125 Stat. 303, 304, provided that, effective upon the expiration of the 1-year period beginning on Sept. 16, 2011, and applicable to any patent issued before, on, or after that effective date, with provisions for graduated implementation, this section is amended to read as follows:

§ 318. Decision of the Board

(a) *Final Written Decision.*—If an inter partes review is instituted and not dismissed under this chapter, the Patent Trial and Appeal Board shall issue a final written decision with respect to the patentability of any patent claim challenged by the petitioner and any new claim added under section 316(d).

(b) *Certificate.*—If the Patent Trial and Appeal Board issues a final written decision under subsection (a) and the time for appeal has expired or any appeal has terminated, the Director shall issue and publish a certificate canceling any claim of the patent finally determined to be unpatentable, confirming any claim of the patent determined to be patentable, and incorporating in the patent by operation of the certificate any new or amended claim determined to be patentable.

(c) *Intervening Rights.*—Any proposed amended or new claim determined to be patentable and incorporated into a patent following an inter partes review under this chapter shall have the same effect as that specified in section 252 for reissued patents on the right of any person who made, purchased, or used within the United States, or imported into the United States, anything patented by such proposed amended or new claim, or who made substantial preparation therefor, before the issuance of a certificate under subsection (b).

(d) *Data on Length of Review.*—The Office shall make available to the public data describing the length of time between the institution of, and the issuance of a final written decision under subsection (a) for, each inter partes review.

See 2011 Amendment note below.

AMENDMENTS

2011—Pub. L. 112–29 amended section generally. Prior to amendment, text read as follows: “Once an order for inter partes reexamination of a patent has been issued under section 313, the patent owner may obtain a stay of any pending litigation which involves an issue of patentability of any claims of the patent which are the subject of the inter partes reexamination order, unless the court before which such litigation is pending determines that a stay would not serve the interests of justice.”

2002—Pub. L. 107–273 made technical correction to directory language of Pub. L. 106–113, which enacted this section.

EFFECTIVE DATE OF 2011 AMENDMENT

Amendment by Pub. L. 112–29 effective upon the expiration of the 1-year period beginning on Sept. 16, 2011, and applicable to any patent issued before, on, or after that effective date, with provisions for graduated implementation, see section 6(c)(2) of Pub. L. 112–29, set out as a note under section 311 of this title.

§ 319. Appeal

A party dissatisfied with the final written decision of the Patent Trial and Appeal Board

under section 318(a) may appeal the decision pursuant to sections 141 through 144. Any party to the inter partes review shall have the right to be a party to the appeal.

(Added Pub. L. 112–29, §6(a), Sept. 16, 2011, 125 Stat. 304.)

EFFECTIVE DATE

Section effective upon the expiration of the 1-year period beginning on Sept. 16, 2011, and applicable to any patent issued before, on, or after that effective date, with provisions for graduated implementation, see section 6(c)(2) of Pub. L. 112–29, set out as an Effective Date of 2011 Amendment note under section 311 of this title.

CHAPTER 32—POST-GRANT REVIEW

Sec.	
321.	Post-grant review.
322.	Petitions.
323.	Preliminary response to petition.
324.	Institution of post-grant review.
325.	Relation to other proceedings or actions.
326.	Conduct of post-grant review.
327.	Settlement.
328.	Decision of the Board.
329.	Appeal.

§ 321. Post-grant review

(a) **IN GENERAL.**—Subject to the provisions of this chapter, a person who is not the owner of a patent may file with the Office a petition to institute a post-grant review of the patent. The Director shall establish, by regulation, fees to be paid by the person requesting the review, in such amounts as the Director determines to be reasonable, considering the aggregate costs of the post-grant review.

(b) **SCOPE.**—A petitioner in a post-grant review may request to cancel as unpatentable 1 or more claims of a patent on any ground that could be raised under paragraph (2) or (3) of section 282(b) (relating to invalidity of the patent or any claim).

(c) **FILING DEADLINE.**—A petition for a post-grant review may only be filed not later than the date that is 9 months after the date of the grant of the patent or of the issuance of a re-issue patent (as the case may be).

(Added Pub. L. 112–29, §6(d), Sept. 16, 2011, 125 Stat. 306.)

EFFECTIVE DATE

Pub. L. 112–29, §6(f)(2), (3), Sept. 16, 2011, 125 Stat. 311, provided that:

“(2) APPLICABILITY.—

“(A) **IN GENERAL.**—The amendments made by subsection (d) [enacting this chapter] shall take effect upon the expiration of the 1-year period beginning on the date of the enactment of this Act [Sept. 16, 2011] and, except as provided in section 18 [set out as a note below] and in paragraph (3), shall apply only to patents described in section 3(n)(1) [set out as an Effective Date of 2011 Amendment; Savings Provisions note under section 100 of this title].

“(B) **LIMITATION.**—The Director [Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office] may impose a limit on the number of post-grant reviews that may be instituted under chapter 32 of title 35, United States Code, during each of the first 4 1-year periods in which the amendments made by subsection (d) are in effect.

“(3) PENDING INTERFERENCES.—

“(A) PROCEDURES IN GENERAL.—The Director shall determine, and include in the regulations issued under paragraph (1) [set out as a note below], the procedures under which an interference commenced before the effective date set forth in paragraph (2)(A) is to proceed, including whether such interference—

“(i) is to be dismissed without prejudice to the filing of a petition for a post-grant review under chapter 32 of title 35, United States Code; or

“(ii) is to proceed as if this Act [see Short Title of 2011 Amendment note set out under section 1 of this title] had not been enacted.

“(B) PROCEEDINGS BY PATENT TRIAL AND APPEAL BOARD.—For purposes of an interference that is commenced before the effective date set forth in paragraph (2)(A), the Director may deem the Patent Trial and Appeal Board to be the Board of Patent Appeals and Interferences, and may allow the Patent Trial and Appeal Board to conduct any further proceedings in that interference.

“(C) APPEALS.—The authorization to appeal or have remedy from derivation proceedings in sections 141(d) and 146 of title 35, United States Code, as amended by this Act, and the jurisdiction to entertain appeals from derivation proceedings in section 1295(a)(4)(A) of title 28, United States Code, as amended by this Act, shall be deemed to extend to any final decision in an interference that is commenced before the effective date set forth in paragraph (2)(A) of this subsection and that is not dismissed pursuant to this paragraph.”

REGULATIONS

Pub. L. 112-29, §6(f)(1), Sept. 16, 2011, 125 Stat. 311, provided that: “The Director [Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office] shall, not later than the date that is 1 year after the date of the enactment of this Act [Sept. 16, 2011], issue regulations to carry out chapter 32 of title 35, United States Code, as added by subsection (d) of this section.”

TRANSITIONAL PROGRAM FOR COVERED BUSINESS METHOD PATENTS

Pub. L. 112-29, §18, Sept. 16, 2011, 125 Stat. 329, provided that:

“(a) TRANSITIONAL PROGRAM.—

“(1) ESTABLISHMENT.—Not later than the date that is 1 year after the date of the enactment of this Act [Sept. 16, 2011], the Director [Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office] shall issue regulations establishing and implementing a transitional post-grant review proceeding for review of the validity of covered business method patents. The transitional proceeding implemented pursuant to this subsection shall be regarded as, and shall employ the standards and procedures of, a post-grant review under chapter 32 of title 35, United States Code, subject to the following:

“(A) Section 321(c) of title 35, United States Code, and subsections (b), (e)(2), and (f) of section 325 of such title shall not apply to a transitional proceeding.

“(B) A person may not file a petition for a transitional proceeding with respect to a covered business method patent unless the person or the person's real party in interest or privy has been sued for infringement of the patent or has been charged with infringement under that patent.

“(C) A petitioner in a transitional proceeding who challenges the validity of 1 or more claims in a covered business method patent on a ground raised under section 102 or 103 of title 35, United States Code, as in effect on the day before the effective date set forth in section 3(n)(1) [set out as an Effective Date of 2011 Amendment; Savings Provisions note under section 100 of this title], may support such ground only on the basis of—

“(i) prior art that is described by section 102(a) of such title of such title [sic] (as in effect on the day before such effective date); or

“(ii) prior art that—

“(I) discloses the invention more than 1 year before the date of the application for patent in the United States; and

“(II) would be described by section 102(a) of such title (as in effect on the day before the effective date set forth in section 3(n)(1)) if the disclosure had been made by another before the invention thereof by the applicant for patent.

“(D) The petitioner in a transitional proceeding that results in a final written decision under section 328(a) of title 35, United States Code, with respect to a claim in a covered business method patent, or the petitioner's real party in interest, may not assert, either in a civil action arising in whole or in part under section 1338 of title 28, United States Code, or in a proceeding before the International Trade Commission under section 337 of the Tariff Act of 1930 (19 U.S.C. 1337), that the claim is invalid on any ground that the petitioner raised during that transitional proceeding.

“(E) The Director may institute a transitional proceeding only for a patent that is a covered business method patent.

“(2) EFFECTIVE DATE.—The regulations issued under paragraph (1) shall take effect upon the expiration of the 1-year period beginning on the date of the enactment of this Act [Sept. 16, 2011] and shall apply to any covered business method patent issued before, on, or after that effective date, except that the regulations shall not apply to a patent described in section 6(f)(2)(A) of this Act [set out as a note above] during the period in which a petition for post-grant review of that patent would satisfy the requirements of section 321(c) of title 35, United States Code.

“(3) SUNSET.—

“(A) IN GENERAL.—This subsection, and the regulations issued under this subsection, are repealed effective upon the expiration of the 8-year period beginning on the date that the regulations issued under to [sic] paragraph (1) take effect.

“(B) APPLICABILITY.—Notwithstanding subparagraph (A), this subsection and the regulations issued under this subsection shall continue to apply, after the date of the repeal under subparagraph (A), to any petition for a transitional proceeding that is filed before the date of such repeal.

“(b) REQUEST FOR STAY.—

“(1) IN GENERAL.—If a party seeks a stay of a civil action alleging infringement of a patent under section 281 of title 35, United States Code, relating to a transitional proceeding for that patent, the court shall decide whether to enter a stay based on—

“(A) whether a stay, or the denial thereof, will simplify the issues in question and streamline the trial;

“(B) whether discovery is complete and whether a trial date has been set;

“(C) whether a stay, or the denial thereof, would unduly prejudice the nonmoving party or present a clear tactical advantage for the moving party; and

“(D) whether a stay, or the denial thereof, will reduce the burden of litigation on the parties and on the court.

“(2) REVIEW.—A party may take an immediate interlocutory appeal from a district court's decision under paragraph (1). The United States Court of Appeals for the Federal Circuit shall review the district court's decision to ensure consistent application of established precedent, and such review may be de novo.

“(c) ATM EXEMPTION FOR VENUE PURPOSES.—In an action for infringement under section 281 of title 35, United States Code, of a covered business method patent, an automated teller machine shall not be deemed to be a regular and established place of business for purposes of section 1400(b) of title 28, United States Code.

“(d) DEFINITION.—

“(1) IN GENERAL.—For purposes of this section, the term ‘covered business method patent’ means a patent that claims a method or corresponding apparatus for performing data processing or other operations used in the practice, administration, or management of a financial product or service, except that the term does not include patents for technological inventions.

“(2) REGULATIONS.—To assist in implementing the transitional proceeding authorized by this subsection, the Director shall issue regulations for determining whether a patent is for a technological invention.

“(e) RULE OF CONSTRUCTION.—Nothing in this section shall be construed as amending or interpreting categories of patent-eligible subject matter set forth under section 101 of title 35, United States Code.”

§ 322. Petitions

(a) REQUIREMENTS OF PETITION.—A petition filed under section 321 may be considered only if—

(1) the petition is accompanied by payment of the fee established by the Director under section 321;

(2) the petition identifies all real parties in interest;

(3) the petition identifies, in writing and with particularity, each claim challenged, the grounds on which the challenge to each claim is based, and the evidence that supports the grounds for the challenge to each claim, including—

(A) copies of patents and printed publications that the petitioner relies upon in support of the petition; and

(B) affidavits or declarations of supporting evidence and opinions, if the petitioner relies on other factual evidence or on expert opinions;

(4) the petition provides such other information as the Director may require by regulation; and

(5) the petitioner provides copies of any of the documents required under paragraphs (2), (3), and (4) to the patent owner or, if applicable, the designated representative of the patent owner.

(b) PUBLIC AVAILABILITY.—As soon as practicable after the receipt of a petition under section 321, the Director shall make the petition available to the public.

(Added Pub. L. 112-29, §6(d), Sept. 16, 2011, 125 Stat. 306.)

EFFECTIVE DATE

Section effective upon the expiration of the 1-year period beginning Sept. 16, 2011, and applicable only to patents described in section 3(n)(1) of Pub. L. 112-29 (35 U.S.C. 100 note), with certain exceptions and limitations, see section 6(f)(2), (3) of Pub. L. 112-29, set out as a note under section 321 of this title.

§ 323. Preliminary response to petition

If a post-grant review petition is filed under section 321, the patent owner shall have the right to file a preliminary response to the petition, within a time period set by the Director, that sets forth reasons why no post-grant review should be instituted based upon the failure of the petition to meet any requirement of this chapter.

(Added Pub. L. 112-29, §6(d), Sept. 16, 2011, 125 Stat. 306.)

EFFECTIVE DATE

Section effective upon the expiration of the 1-year period beginning Sept. 16, 2011, and applicable only to patents described in section 3(n)(1) of Pub. L. 112-29 (35 U.S.C. 100 note), with certain exceptions and limitations, see section 6(f)(2), (3) of Pub. L. 112-29, set out as a note under section 321 of this title.

§ 324. Institution of post-grant review

(a) THRESHOLD.—The Director may not authorize a post-grant review to be instituted unless the Director determines that the information presented in the petition filed under section 321, if such information is not rebutted, would demonstrate that it is more likely than not that at least 1 of the claims challenged in the petition is unpatentable.

(b) ADDITIONAL GROUNDS.—The determination required under subsection (a) may also be satisfied by a showing that the petition raises a novel or unsettled legal question that is important to other patents or patent applications.

(c) TIMING.—The Director shall determine whether to institute a post-grant review under this chapter pursuant to a petition filed under section 321 within 3 months after—

(1) receiving a preliminary response to the petition under section 323; or

(2) if no such preliminary response is filed, the last date on which such response may be filed.

(d) NOTICE.—The Director shall notify the petitioner and patent owner, in writing, of the Director’s determination under subsection (a) or (b), and shall make such notice available to the public as soon as is practicable. Such notice shall include the date on which the review shall commence.

(e) NO APPEAL.—The determination by the Director whether to institute a post-grant review under this section shall be final and nonappealable.

(Added Pub. L. 112-29, §6(d), Sept. 16, 2011, 125 Stat. 306.)

EFFECTIVE DATE

Section effective upon the expiration of the 1-year period beginning Sept. 16, 2011, and applicable only to patents described in section 3(n)(1) of Pub. L. 112-29 (35 U.S.C. 100 note), with certain exceptions and limitations, see section 6(f)(2), (3) of Pub. L. 112-29, set out as a note under section 321 of this title.

§ 325. Relation to other proceedings or actions

(a) INFRINGER’S CIVIL ACTION.—

(1) POST-GRANT REVIEW BARRED BY CIVIL ACTION.—A post-grant review may not be instituted under this chapter if, before the date on which the petition for such a review is filed, the petitioner or real party in interest filed a civil action challenging the validity of a claim of the patent.

(2) STAY OF CIVIL ACTION.—If the petitioner or real party in interest files a civil action challenging the validity of a claim of the patent on or after the date on which the petitioner files a petition for post-grant review of the patent, that civil action shall be automatically stayed until either—

(A) the patent owner moves the court to lift the stay;

(B) the patent owner files a civil action or counterclaim alleging that the petitioner or real party in interest has infringed the patent; or

(C) the petitioner or real party in interest moves the court to dismiss the civil action.

(3) TREATMENT OF COUNTERCLAIM.—A counterclaim challenging the validity of a claim of a patent does not constitute a civil action challenging the validity of a claim of a patent for purposes of this subsection.

(b) PRELIMINARY INJUNCTIONS.—If a civil action alleging infringement of a patent is filed within 3 months after the date on which the patent is granted, the court may not stay its consideration of the patent owner's motion for a preliminary injunction against infringement of the patent on the basis that a petition for post-grant review has been filed under this chapter or that such a post-grant review has been instituted under this chapter.

(c) JOINDER.—If more than 1 petition for a post-grant review under this chapter is properly filed against the same patent and the Director determines that more than 1 of these petitions warrants the institution of a post-grant review under section 324, the Director may consolidate such reviews into a single post-grant review.

(d) MULTIPLE PROCEEDINGS.—Notwithstanding sections 135(a), 251, and 252, and chapter 30, during the pendency of any post-grant review under this chapter, if another proceeding or matter involving the patent is before the Office, the Director may determine the manner in which the post-grant review or other proceeding or matter may proceed, including providing for the stay, transfer, consolidation, or termination of any such matter or proceeding. In determining whether to institute or order a proceeding under this chapter, chapter 30, or chapter 31, the Director may take into account whether, and reject the petition or request because, the same or substantially the same prior art or arguments previously were presented to the Office.

(e) ESTOPPEL.—

(1) PROCEEDINGS BEFORE THE OFFICE.—The petitioner in a post-grant review of a claim in a patent under this chapter that results in a final written decision under section 328(a), or the real party in interest or privy of the petitioner, may not request or maintain a proceeding before the Office with respect to that claim on any ground that the petitioner raised or reasonably could have raised during that post-grant review.

(2) CIVIL ACTIONS AND OTHER PROCEEDINGS.—The petitioner in a post-grant review of a claim in a patent under this chapter that results in a final written decision under section 328(a), or the real party in interest or privy of the petitioner, may not assert either in a civil action arising in whole or in part under section 1338 of title 28 or in a proceeding before the International Trade Commission under section 337 of the Tariff Act of 1930 that the claim is invalid on any ground that the petitioner raised or reasonably could have raised during that post-grant review.

(f) REISSUE PATENTS.—A post-grant review may not be instituted under this chapter if the petition requests cancellation of a claim in a reissue patent that is identical to or narrower than a claim in the original patent from which the reissue patent was issued, and the time limitations in section 321(c) would bar filing a petition for a post-grant review for such original patent.

(Added Pub. L. 112-29, §6(d), Sept. 16, 2011, 125 Stat. 307.)

REFERENCES IN TEXT

Section 337 of the Tariff Act of 1930, referred to in subsec. (e)(2), is classified to section 1337 of Title 19, Customs Duties.

EFFECTIVE DATE

Section effective upon the expiration of the 1-year period beginning Sept. 16, 2011, and applicable only to patents described in section 3(n)(1) of Pub. L. 112-29 (35 U.S.C. 100 note), with certain exceptions and limitations, see section 6(f)(2), (3) of Pub. L. 112-29, set out as a note under section 321 of this title.

§ 326. Conduct of post-grant review

(a) REGULATIONS.—The Director shall prescribe regulations—

(1) providing that the file of any proceeding under this chapter shall be made available to the public, except that any petition or document filed with the intent that it be sealed shall, if accompanied by a motion to seal, be treated as sealed pending the outcome of the ruling on the motion;

(2) setting forth the standards for the showing of sufficient grounds to institute a review under subsections (a) and (b) of section 324;

(3) establishing procedures for the submission of supplemental information after the petition is filed;

(4) establishing and governing a post-grant review under this chapter and the relationship of such review to other proceedings under this title;

(5) setting forth standards and procedures for discovery of relevant evidence, including that such discovery shall be limited to evidence directly related to factual assertions advanced by either party in the proceeding;

(6) prescribing sanctions for abuse of discovery, abuse of process, or any other improper use of the proceeding, such as to harass or to cause unnecessary delay or an unnecessary increase in the cost of the proceeding;

(7) providing for protective orders governing the exchange and submission of confidential information;

(8) providing for the filing by the patent owner of a response to the petition under section 323 after a post-grant review has been instituted, and requiring that the patent owner file with such response, through affidavits or declarations, any additional factual evidence and expert opinions on which the patent owner relies in support of the response;

(9) setting forth standards and procedures for allowing the patent owner to move to amend the patent under subsection (d) to cancel a challenged claim or propose a reasonable number of substitute claims, and ensuring

that any information submitted by the patent owner in support of any amendment entered under subsection (d) is made available to the public as part of the prosecution history of the patent;

(10) providing either party with the right to an oral hearing as part of the proceeding;

(11) requiring that the final determination in any post-grant review be issued not later than 1 year after the date on which the Director notices the institution of a proceeding under this chapter, except that the Director may, for good cause shown, extend the 1-year period by not more than 6 months, and may adjust the time periods in this paragraph in the case of joinder under section 325(c); and

(12) providing the petitioner with at least 1 opportunity to file written comments within a time period established by the Director.

(b) **CONSIDERATIONS.**—In prescribing regulations under this section, the Director shall consider the effect of any such regulation on the economy, the integrity of the patent system, the efficient administration of the Office, and the ability of the Office to timely complete proceedings instituted under this chapter.

(c) **PATENT TRIAL AND APPEAL BOARD.**—The Patent Trial and Appeal Board shall, in accordance with section 6, conduct each post-grant review instituted under this chapter.

(d) **AMENDMENT OF THE PATENT.**—

(1) **IN GENERAL.**—During a post-grant review instituted under this chapter, the patent owner may file 1 motion to amend the patent in 1 or more of the following ways:

(A) Cancel any challenged patent claim.

(B) For each challenged claim, propose a reasonable number of substitute claims.

(2) **ADDITIONAL MOTIONS.**—Additional motions to amend may be permitted upon the joint request of the petitioner and the patent owner to materially advance the settlement of a proceeding under section 327, or upon the request of the patent owner for good cause shown.

(3) **SCOPE OF CLAIMS.**—An amendment under this subsection may not enlarge the scope of the claims of the patent or introduce new matter.

(e) **EVIDENTIARY STANDARDS.**—In a post-grant review instituted under this chapter, the petitioner shall have the burden of proving a proposition of unpatentability by a preponderance of the evidence.

(Added Pub. L. 112-29, §6(d), Sept. 16, 2011, 125 Stat. 308.)

EFFECTIVE DATE

Section effective upon the expiration of the 1-year period beginning Sept. 16, 2011, and applicable only to patents described in section 3(n)(1) of Pub. L. 112-29 (35 U.S.C. 100 note), with certain exceptions and limitations, see section 6(f)(2), (3) of Pub. L. 112-29, set out as a note under section 321 of this title.

§ 327. Settlement

(a) **IN GENERAL.**—A post-grant review instituted under this chapter shall be terminated with respect to any petitioner upon the joint request of the petitioner and the patent owner, un-

less the Office has decided the merits of the proceeding before the request for termination is filed. If the post-grant review is terminated with respect to a petitioner under this section, no estoppel under section 325(e) shall attach to the petitioner, or to the real party in interest or privy of the petitioner, on the basis of that petitioner's institution of that post-grant review. If no petitioner remains in the post-grant review, the Office may terminate the post-grant review or proceed to a final written decision under section 328(a).

(b) **AGREEMENTS IN WRITING.**—Any agreement or understanding between the patent owner and a petitioner, including any collateral agreements referred to in such agreement or understanding, made in connection with, or in contemplation of, the termination of a post-grant review under this section shall be in writing, and a true copy of such agreement or understanding shall be filed in the Office before the termination of the post-grant review as between the parties. At the request of a party to the proceeding, the agreement or understanding shall be treated as business confidential information, shall be kept separate from the file of the involved patents, and shall be made available only to Federal Government agencies on written request, or to any person on a showing of good cause.

(Added Pub. L. 112-29, §6(d), Sept. 16, 2011, 125 Stat. 310.)

EFFECTIVE DATE

Section effective upon the expiration of the 1-year period beginning Sept. 16, 2011, and applicable only to patents described in section 3(n)(1) of Pub. L. 112-29 (35 U.S.C. 100 note), with certain exceptions and limitations, see section 6(f)(2), (3) of Pub. L. 112-29, set out as a note under section 321 of this title.

§ 328. Decision of the Board

(a) **FINAL WRITTEN DECISION.**—If a post-grant review is instituted and not dismissed under this chapter, the Patent Trial and Appeal Board shall issue a final written decision with respect to the patentability of any patent claim challenged by the petitioner and any new claim added under section 326(d).

(b) **CERTIFICATE.**—If the Patent Trial and Appeal Board issues a final written decision under subsection (a) and the time for appeal has expired or any appeal has terminated, the Director shall issue and publish a certificate canceling any claim of the patent finally determined to be unpatentable, confirming any claim of the patent determined to be patentable, and incorporating in the patent by operation of the certificate any new or amended claim determined to be patentable.

(c) **INTERVENING RIGHTS.**—Any proposed amended or new claim determined to be patentable and incorporated into a patent following a post-grant review under this chapter shall have the same effect as that specified in section 252 for reissued patents on the right of any person who made, purchased, or used within the United States, or imported into the United States, anything patented by such proposed amended or new claim, or who made substantial preparation therefor, before the issuance of a certificate under subsection (b).

(d) DATA ON LENGTH OF REVIEW.—The Office shall make available to the public data describing the length of time between the institution of, and the issuance of a final written decision under subsection (a) for, each post-grant review. (Added and amended Pub. L. 112–29, §§ 6(d), 20(j), Sept. 16, 2011, 125 Stat. 310, 335.)

AMENDMENTS

2011—Subsec. (c). Pub. L. 112–29, § 20(j), struck out “of this title” after “252”.

EFFECTIVE DATE OF 2011 AMENDMENT

Amendment by section 20(j) of Pub. L. 112–29 effective upon the expiration of the 1-year period beginning on Sept. 16, 2011, and applicable to proceedings commenced on or after that effective date, see section 20(l) of Pub. L. 112–29, set out as a note under section 2 of this title.

EFFECTIVE DATE

Section effective upon the expiration of the 1-year period beginning Sept. 16, 2011, and applicable only to patents described in section 3(n)(1) of Pub. L. 112–29 (35 U.S.C. 100 note), with certain exceptions and limitations, see section 6(f)(2), (3) of Pub. L. 112–29, set out as a note under section 321 of this title.

§ 329. Appeal

A party dissatisfied with the final written decision of the Patent Trial and Appeal Board under section 328(a) may appeal the decision pursuant to sections 141 through 144. Any party to the post-grant review shall have the right to be a party to the appeal.

(Added Pub. L. 112–29, § 6(d), Sept. 16, 2011, 125 Stat. 311.)

EFFECTIVE DATE

Section effective upon the expiration of the 1-year period beginning Sept. 16, 2011, and applicable only to patents described in section 3(n)(1) of Pub. L. 112–29 (35 U.S.C. 100 note), with certain exceptions and limitations, see section 6(f)(2), (3) of Pub. L. 112–29, set out as a note under section 321 of this title.

PART IV—PATENT COOPERATION TREATY

Chap.		Sec.
35.	Definitions	351
36.	International Stage	361
37.	National Stage	371

CODIFICATION

Analysis of chapters editorially supplied. Part IV added by Pub. L. 94–131 without adding analysis for chapters 35, 36, and 37.

Pub. L. 96–517 purported to amend the table of chapters of title 35 by adding after the item for chapter 37 the following: “38. Patent Rights in Inventions Made with Federal Assistance”. Title 35 did not contain a table of chapters, and section 6(b) of Pub. L. 96–517 and the purported amendment made by it were repealed by Pub. L. 97–256. See chapter 18 (§ 200 et seq.) of this title.

CHAPTER 35—DEFINITIONS

Sec.	
351.	Definitions.

§ 351. Definitions

When used in this part unless the context otherwise indicates—

(a) The term “treaty” means the Patent Cooperation Treaty done at Washington, on June 19, 1970.

(b) The term “Regulations”, when capitalized, means the Regulations under the treaty, done at Washington on the same date as the treaty. The term “regulations”, when not capitalized, means the regulations established by the Director under this title.

(c) The term “international application” means an application filed under the treaty.

(d) The term “international application originating in the United States” means an international application filed in the Patent and Trademark Office when it is acting as a Receiving Office under the treaty, irrespective of whether or not the United States has been designated in that international application.

(e) The term “international application designating the United States” means an international application specifying the United States as a country in which a patent is sought, regardless where such international application is filed.

(f) The term “Receiving Office” means a national patent office or intergovernmental organization which receives and processes international applications as prescribed by the treaty and the Regulations.

(g) The terms “International Searching Authority” and “International Preliminary Examining Authority” mean a national patent office or intergovernmental organization as appointed under the treaty which processes international applications as prescribed by the treaty and the Regulations.

(h) The term “International Bureau” means the international intergovernmental organization which is recognized as the coordinating body under the treaty and the Regulations.

(i) Terms and expressions not defined in this part are to be taken in the sense indicated by the treaty and the Regulations.

(Added Pub. L. 94–131, § 1, Nov. 14, 1975, 89 Stat. 685; amended Pub. L. 98–622, title IV, § 403(a), Nov. 8, 1984, 98 Stat. 3392; Pub. L. 99–616, § 2(a)–(c), Nov. 6, 1986, 100 Stat. 3485; Pub. L. 106–113, div. B, § 1000(a)(9) [title IV, § 4732(a)(10)(A)], Nov. 29, 1999, 113 Stat. 1536, 1501A–582; Pub. L. 107–273, div. C, title III, § 13206(b)(1)(B), Nov. 2, 2002, 116 Stat. 1906.)

AMENDMENTS

2002—Subsec. (b). Pub. L. 107–273 made technical correction to directory language of Pub. L. 106–113. See 1999 Amendment note below.

1999—Subsec. (b). Pub. L. 106–113, as amended by Pub. L. 107–273, substituted “Director” for “Commissioner”.

1986—Subsec. (a). Pub. L. 99–616, § 2(a), struck out “, excluding chapter II thereof” after “June 19, 1970”.

Subsec. (b). Pub. L. 99–616, § 2(b), struck out “excluding part C thereof” after “under the treaty”.

Subsec. (g). Pub. L. 99–616, § 2(c), substituted “The terms ‘International Searching Authority’ and ‘International Preliminary Examining Authority’ mean” for “The term ‘International Searching Authority’ means”.

1984—Subsec. (d). Pub. L. 98–622 substituted “Patent and Trademark Office” for “Patent Office”.

EFFECTIVE DATE OF 1999 AMENDMENT

Amendment by Pub. L. 106–113 effective 4 months after Nov. 29, 1999, see section 1000(a)(9) [title IV, § 4731] of Pub. L. 106–113, set out as a note under section 1 of this title.